REMARKS

Claims 1, 2, 4, 5, 8-18, 20 and 22 are pending in the subject application and currently under consideration. Favorable reconsideration of the subject application is respectfully requested in view of the comments herein.

I.   Rejection of Claims 1, 2, 4, 5, 8-18, 20 and 22 under 35 U.S.C. §103(a)

Claims 1, 2, 4, 5, 8-18, 20 and 22 stand rejected under 35 U.S.C. §103(a) as being unpatenable over Barclay et al. (5,960,399). Withdrawal of this rejection is respectfully requested for at least the following reasons. Barclay et al. does not teach or suggest the subject invention as claimed. Moreover, Barclay et al. teaches away from the subject invention.

> To reject claims in an application under 35 U.S.C. an Examiner must show an unrebutted *prima facie* case of obviousness. Generally, a *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. *See* MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *See In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

A.   Barclay *et al.* Fails to Teach or Suggest the Claimed Invention.

With regard to the instant application, applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness and instead, has improperly determined patentability by mischaracterizing the teachings of Barclay *et al.* in general, and further, improperly combining portions thereof with respect to the claimed invention. Independent claim 1, 12, 18, 20 and 22 recites in part: a host computer communicating a GUI file tu a mobile terminal, the GUI file having attached thereto a dictionary file having *phonemes* and a syntax file having allowable patterns of words being content specific to the graphical display file.

Barclay *et al.* does not teach or suggest ***communicating*** a dictionary file having phonemes from ***a host computer to a mobile device***. As noted by the Examiner, the background of Barclay discusses employment of Hidden Markov Models (HMMs) and phonemes to ***decode*** speech. Nowhere in Barclay *et al.* is it taught or suggested that the HMMs or phonemes are communicated from the host computer to the remote device in order to mitigate memory/processing requirements of the remote device as recited in the present invention. Therefore, Barclay *et al.* does not teach or suggest the limitations of the recited claims, wherein it is respectfully submitted that a *prima facie* case of obviousness has not been established and this rejection should be withdrawn.

B. Barclay *et al.* Teaches Away from the Claimed Invention.

Moreover, Barclay *et al.* teaches away from the claimed invention.

> A prior art reference must be considered in its entirety, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.,* 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert denied, 469 U.S. 851 (1984). (*See* MPEP 2141.02). The Federal Circuit has noted: [A]s a "useful general rule," that references that teach away cannot serve to create a *prima facie* case of obviousness. *In re Gurley,* 27 F.3d 551, 553, 31 U.S.P.Q.2D (BNA) 1130, 1132 (Fed. Cir. 1994).

At page 4 of Paper No. 17, the Examiner responds that "*However, this teaching* (Barclay *et al.*) *still renders it obvious to keep a limited vocabulary at the client machine.*" It is respectfully submitted that this argument and the disclosure in Barclay *et al.* teaches away from the benefits of the claimed invention which is to keep ***NO*** vocabulary - limited or otherwise, at the client machine.

At most, Barclay *et al.* discusses a technology referred to as SAM that enables smart WEB pages having downloadable grammar that is specific to syntax (*e.g., **words and phrases***) to be executed on a client machine. Examples of the downloadable grammar are given as "Show me the weather in Boston." Since ***only*** words and phrases are taught as being downloaded in Barclay *et al.*, speech decoding mechanisms such as HMMs and phonemes ***must*** be resident at the client machine *a priori* in order to process speech - thus, defeating the purpose and utility of the claimed invention. Therefore, storing additional data at the client machine to decode speech as suggested in Barclay *et al.*

is a teaching away from the present invention. In view of the above, it is respectfully submitted this rejection be withdrawn.

II.   Conclusion

The present application is believed to be in condition for allowance in view of the above amendments and comments.

If any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,
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